

## **REMARKS**

### **Status of the Claims**

Upon entry of the amendment above, claims 1-23 will be pending, claims 1, 5, 7, and 18 being independent.

### **Summary of the Office Action**

Claims 1-4 are rejected under 35 USC §103(a) as being unpatentable over POLIFRONI (U.S. Patent No. 6,817,115 or US Patent Application Publication No. 2003/0061739).

Claims 5 and 6 are rejected under 35 USC §102(e) over POLIFRONI.

Claims 7 and 10 are rejected under 35 USC §103(a) as being unpatentable over BONAVENTURE (U.S. Patent No. 5,228,218) in view of POLIFRONI or BAUERFEIND (U.S. Patent No. 5,438,768).

Claims 8 and 9 are rejected under 35 USC §103(a) as being unpatentable over BONAVENTURE in view of POLIFRONI or BAUERFEIND and further in view of MAREGA (U.S. Patent No. 4,920,666).

### **Response to the Office Action**

#### **A. Summary of the Amendment**

In the amendment above, Applicants have made cosmetic revisions to paragraphs 0002 and 0011. In addition, independent claim 1 has been amended to change "an abrasive paper" to "an abrasive paper or fabric," consistent with the specification. In addition, claim 3 has been rewritten in independent form and new claims 11-23 have been added, of which claim 18 is independent.

#### **B. Withdrawal of Rejection of Claims 5 and 6**

Claims 5 and 6 are directed to an article of footwear that includes an inner sole having an abrasive insert between the lower surface of the inner sole and the bottom of the footwear. Dependent claim 6 specifies that the insert is fixed to the lower surface of the inner sole. Applicants kindly request reconsideration and withdrawal of the rejection thereof.

POLIFRONI discloses an arch support device to be fitted inside an article of footwear which includes a lower surface having, at least partially, a roughened/anti-slip surface or a rubber insert or a thin layer of rubber.

POLIFRONI's arch support is a molded piece, which is "rigid or semi-rigid plastic material" (column 3, lines 1-2) and that, unlike Applicants' specification (paragraph 0003), POLIFRONI describes no concern about minimizing the total thickness between the wearer's foot and the terrain upon which the footwear contacts, nor of preventing unintended deforming the inner sole into an accordion shape when the foot is removed from an article of footwear. Instead, as explained in column 5, lines 6-15, POLIFRONI is concerned with resisting "slipping of the foot relative to the arch support and resultant potential misalignment of the foot with the arch support, which would be uncomfortable."

With particular regard to the wording of the rejected claims, POLIFRONI does not disclose the slip-resistant surfaces as being *abrasive* surfaces.

In contrast to Applicants' claims, the two embodiments disclosed by POLIFRONI share the characteristic that their anti-slip property is a *non-destructive* property. In a first embodiment, a "roughened or frosted surface texture" is provided, as mentioned in column 3, lines 23-25. Such texture is provided as part of an injection-molded part. Although "sand-blasting" is mentioned (column 3, lines 26-31), such abrasive step is achieved in manufacturing the insert; the inserts themselves, however, are not described as abrasive; the inserts do not *abrade* upon the surface upon which it rests.

In a second embodiment, POLIFRONI discloses the use of rubber inserts or a thin layer of rubber, as described in column 4, lines 43-65, with reference to the embodiment shown in Figs. 6 and 7. POLIFRONI discloses that the insert 48 (under the heel) and the insert 49 (under the toe region) are "slip resistant inserts (column 4, line 48). The purpose of the anti-slip surfaces are said to "resist slipping of the device 40 relative to the footwear" (column 4, lines 55-58).

At least because of the foregoing, reconsideration and withdrawal of the rejection of claims 5 and 6 is kindly requested.

New claims 13 and 14 depend from claim 5 and specify, respectively, that the abrasive insert provides an abrasive anti-slip feature for the inner sole only upon a certain downward pressure being exerted on the inner sole, and that the abrasive insert comprises a sheet of paper or fabric having a coating of abrasive particles. As mentioned above, POLIFRONI discloses a molded arch support, with the textured surface being created other than by means of a coating of abrasive particles.

**C. Withdrawal of Rejection of Claims 1-4**

Claims 1-4 are directed to an inner sole for an article of footwear that includes an anti-slip insert comprising an abrasive paper or fabric positioned in the metatarsophalangeal articulation area thereof. Applicants kindly request reconsideration and withdrawal of the rejection thereof.

As just mentioned, POLIFRONI discloses a molded arch support, with the textured surface being created other than by means of a coating of abrasive particles. Therefore, even conceding, for the sake of argument, that one skilled in the art might know to select a material on the basis of its suitability for an intended use, as mentioned in the rejection, Applicants respectfully submit, as mentioned in the Manual of Patent Examining Procedure (MPEP), Section 2143.01, that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there would be no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

In this regard, "rubber or the like," which is mentioned by POLIFRONI in column 4, line 50, cited in the rejection, would not encompass an abrasive paper ("or fabric," added to claim 1 by amendment above). In column 4, lines 55-56, POLIFRONI explains that the inserts 48, 49 (i.e., the *rubber* inserts) "will engage the sole of the footwear in which the device is placed ...."

Applicants acknowledge that using an *abrasive* material, the anti-slip property of their invention is obtained at a certain cost, i.e., the abrasion of the surface on which the inner sole rests. It also has the advantage that such anti-slip property is not effective

when there is no vertical pressure on the sole. This advantage is not believed to be present for the embodiments disclosed by POLIFRONI.

New claims 11 and 12 depend from claim 1 and specify, respectively, that the abrasive paper or fabric provides an abrasive anti-slip feature for the inner sole only upon a certain downward pressure being exerted on the inner sole, and that the abrasive paper or fabric comprises a sheet of paper or fabric having a coating of abrasive particles.

At least because of the foregoing, reconsideration and withdrawal of the rejection of claim 1 is kindly requested.

**D. Withdrawal of Rejection of Claims 7 and 10**

Independent claim 7 is directed to a sports boot that includes a shell and a liner, with an inner sole with an abrasive insert between the lower surface of the inner sole and the support surface of the liner. Applicants kindly request reconsideration and withdrawal of the rejection thereof.

First, with regard to the combination of BONAVENTURE and POLIFRONI, Applicants submit that one skilled in the art of the invention, such as the invention of BONAVENTURE, would not likely consider using a rigid arch support made of a molded plastic material, as disclosed by POLIFRONI, particularly because it would tend to lessen the quality and extent of feedback that a skier would enjoy otherwise.

Further, Applicants respectfully traverse the reliance upon POLIFRONI for reasons advanced above in connection with the rejection of claims 1-6.

With regard to the secondary teachings of BAUERFEIND, Applicants have read the specification of BAUERFEIND carefully, but the particular teachings upon which the rejection might rely are not clearly evident.

With regard to BAUERFEIND, the only hint of an *abrasive* surface, it would appear, is the description in column 3, lines 46-52, and that disclosure does not appear clear or relevant. There, BAUERFEIND seems to be saying that if only the “wrong” half of the Velcro-type fastening members were used, there would be a “roughness” (column

3, line 51) facing down on the inside sole of the shoe. But the relevance of this is not seem clear at all. First, it would seem that BAUERFEIND does not recommend using only half of the fastening members; instead, the “covering part 14” covers the “bearing part 12”. Second, BAUERFEIND seems to be saying that if only one-half of the fastening members are to be used, the “hooked part” should *not* be used because there would be a roughness.

Applicants have noted that, in both embodiments, *i.e.*, in Figs. 1, 2 and Fig. 3, BAUERFEIND includes “adhering parts” (column 2, line 65), each of which includes a “covering sheet 20” (column 2, line 67). In the sentence from column 2, line 68, to column 3, line 4, once the covering sheets are removed from the adhering parts, the inserted sole 1 is then securely positioned in the shoe. However, there seem to be at least two points that distinguish these parts 18 from Applicants’ invention. First, these bearing parts are not positioned in the metatarsophalangeal area (although, Applicants have added such limitation in new claim 17, which depends from claim 7). Second, the adhering parts 18, Applicants submit, likely have *adhesive* surfaces; not *abrasive*. Thereby, after the sole 1 is positioned within the shoe, repeated removal and insertion would be impractical and, therefore, not responsive to the “removable and non-fixed” limitation in claim 7.

At least for the foregoing reasons, reconsideration and withdrawal of the rejection of claims 7 and 10 is kindly requested.

New claims 15 and 16 (in addition to new claim 17, mentioned above) depend from claim 7 and specify, respectively, that the abrasive insert provides an abrasive anti-slip feature for the inner sole only upon a certain downward pressure being exerted on the inner sole, and that the abrasive insert comprises a sheet of paper or fabric having a coating of abrasive particles. Neither of POLIFRONI and BAUERFEIND teach or suggest same.

**E. Withdrawal of Rejection of Claims 8 and 9**

Claims 8 and 9 depend serially from independent claim 7. Claim 8 describes additional details of the liner, *i.e.*, the liner including a lasting sole and an upper sewn together; claim 9 depends from claim 8 and adds that the inner sole of the invention is in contact with the lasting sole. Applicants kindly request reconsideration and withdrawal of the rejection of claims 8 and 9 at least for reasons given above with regard to parent claim 7.

**F. New Claims 18-23**

New claim 18 is independent and claims 19-23 depend therefrom. Claim 18 is directed to an article of footwear that includes, *inter alia*, an inner sole having an abrasive surface affixed to a lower surface thereof, such abrasive surface providing an anti-slip feature for the inner sole only upon a certain downward pressure being exerted on the inner sole, whereby the abrasive surface comprises "means for preventing said insole from being driven rearward upon extraction of the foot from the article of footwear and for preventing said inner sole from deforming during extraction of the foot from the article of footwear." With the substantial thicknesses and materials of the foot-supporting structures of POLIFRONI and BAUERFEIND, Applicants submit that one skilled in the art would not find their disclosures as suggesting any modification of an article of footwear that would meet the terms of claim 18.

New claim 19 depends from claim 18 and further specifies that the abrasive surface of claim 18 comprises a flexible sheet of paper or fabric and that the abrasive surface of claim 18 comprises a coating of abrasive particles on said flexible sheet of paper or fabric.

New claim 20 depends from claim 19 and further specifies that the coating of abrasive particles is positioned at least in a metatarsophalangeal articulation area of the inner sole.

New claim 21 depends from claim 18 and calls for the abrasive surface to comprise a coating of an abrasive amalgam applied by means of a spray gun or a brush.

New claim 22 depends from claim 21 and calls for the coating of abrasive amalgam to be located at least in a metatarsophalangeal articulation area of said inner sole.

Finally, new claim 23 depends from claim 18 and limits the scope of the article of footwear to comprise "a sports boot comprising a rigid plastic shell and a removable liner positioned within said rigid plastic shell, said upper is an upper of said removable liner, with the inner sole being removably positioned within the liner and not fixed in place relative to the liner.

### **SUMMARY AND CONCLUSION**

The grounds of rejection advanced in the Office action has been addressed and is believed to be overcome. Reconsideration and allowance are respectfully requested in view of the amendment and remarks above.

A check is attached for payment of a claim fee and for payment of a fee for an extension of time. However, the Commissioner is authorized to charge any fee required for acceptance of this reply as timely and complete to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone or fax number given below.

Respectfully submitted,  
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